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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,143	12/02/2003	David K. Swanson	015916-301	5314

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EXAMINER

ROANE, AARON F

ART UNIT PAPER NUMBER

3739

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/727,143	Applicant(s) SWANSON, DAVID K.	
	Examiner Aaron Roane	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 7, 11-26, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/28/06, 11/18/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 6/17/05</u> |

DETAILED ACTION

Election/Restrictions

Claims 11-26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/13/2006.

Claims 7, 37 and 38 have been withdrawn as being directed to a non-elected species, the elected specie being the specie characterized by figures 1 and 2.

Additionally, Applicant traverses the species distinct characterization between figures 1 and 2 and states in the response filed 7/13/2006, that figures 1 and 2 depict the same specie. The examiner agrees and hereby views figures 1 and 2 as illustrating the same specie.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by *Bowe et al.* (USPN 6,771,996).

Regarding claims 1-5 and 8-10, *Bowe et al.* disclose a surgical probe, comprising: a relatively short shaft (34 and any equivalent counterparts of other embodiments) defining a distal region and a proximal region; a coagulation element, a set of coagulation electrodes (94 and any equivalent counterparts of other embodiments) defining a coagulation element configuration on the distal region of the relatively short shaft; and a stimulation element, a set of stimulation electrodes (114 and 116 and any equivalent counterparts of other embodiments) defining a stimulation element configuration on the distal region of the relatively short shaft, the stimulation element configuration being different than the coagulation element configuration, wherein the length of any coagulation electrode is longer than the length of any stimulation electrode, see col. 7-16, particularly col. 8-10 and figures 1-16, particularly figures 1-3.

Regarding claim 6, *Bowe et al.* disclose the claimed invention, see col. 14, lines 28-42.

Regarding claim 8, *Bowe et al.* disclose the claimed invention, see col. 3, lines 42-61, col. 10, line 55 through col. 11, line 7 and figure 8.

Regarding claims 9 and 10, *Bowe et al.* disclose a handle (28 and 49 collectively) associated with the proximal region of the relatively short shaft and the stimulation

element(s) is(are) located distally of the coagulation element(s), see col. 7-16, particularly col. 8-10 and figures 1-16, particularly figures 1-3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-10 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Bowe et al. (USPN 6,771,996) in view of Whayne et al. (USPN 6,115,626).

Regarding claims 1-5, 27, 28 and 31-33 Bowe et al. disclose a source of coagulation energy (16), a surgical probe, comprising: a relatively short shaft (34 and any equivalent counterparts of other embodiments) defining a distal region and a proximal region; a coagulation element, a set of coagulation electrodes (94 and any equivalent counterparts of other embodiments) defining a coagulation element configuration on the distal region of the relatively short shaft; and a stimulation element, a set of stimulation electrodes (114 and 116 and any equivalent counterparts of other embodiments) defining a stimulation element configuration on the distal region of the relatively short shaft, the stimulation element configuration being different than the coagulation element

configuration, wherein the length of any coagulation electrode is longer than the length of any stimulation electrode, see col. 7-16, particularly col. 8-10 and figures 1-16, particularly figures 1-3. Bowe et al. fail to disclose a source of stimulation energy connected to the stimulation electrode(s). Whayne et al. disclose a method and system for mapping and ablating tissue and teach "the techniques used to analyze these pathways, commonly called "mapping," identify regions in the heart tissue, called foci, which can be ablated to treat the arrhythmia. When used for this purpose, the multiple electrode arrays are typically located in electrical contact with either epicardial or endocardial tissue. The multiple electrodes are coupled to an external cardiac stimulator, which applies electrical pacing signals through one or more electrodes at given frequencies, durations, or amplitudes to myocardial tissue, a process called "pacing." The multiple electrodes on the array are also typically coupled to signal processing equipment, called "recorders," which display the morphologies of the electrocardiograms or electrograms recorded during pacing. Sometimes, another roving electrode is deployed in association with the multiple electrode array, to pace the heart at various endocardial locations, a technique called 'pace mapping.' When it is desired to ablate myocardial tissue, an electrode coupled to a source of, e.g., radio frequency energy is deployed," see col. 1, lines 19-38. Whayne et al. provides mapping electrodes that have the dual capability of stimulation/pacing in order to provide mapping capability of the targeted tissue. The stimulator (20) of Whayne et al. serves as the source of stimulation energy, see figure 2. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Bowe et al., as taught by

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Whayne et al., to provide mapping electrodes that have the dual capability of stimulation/pacing in order to provide mapping capability of the targeted tissue.

Regarding claims 6 and 34, Bowe et al. disclose the claimed invention, see col. 14, lines 28-42.

Regarding claims 8 and 35, Bowe et al. disclose the claimed invention, see col. 3, lines 42-61, col. 10, line 55 through col. 11, line 7 and figure 8.

Regarding claim 29, Bowe et al. in view of Whayne et al. disclose the claimed invention.

Regarding claim 30, Bowe et al. in view of Whayne et al. disclose a handle (28 and 49 collectively) associated with the proximal region of the relatively short shaft; wherein the coagulation energy connector is carried by the handle and the stimulation energy line extends through the handle, see figure 1 in the Bowe et al. patent.

Regarding claim 36, Bowe et al. in view of Whayne et al. disclose the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.R. *A.R.*
August 16, 2006

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER